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Docket No.: 209396US2X



ATTORNEYS AT LAW

NORMAN F. OBLON
(703) 413-3000
NOBLON@OBLON.COMROBERT T. POUS
(703) 413-3000
RPOUS@OBLON.COMCOMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313RE: Application Serial No.: 09/874,057
Applicants: Takehiro NISHIYAMA
Filing Date: June 6, 2001
For: METHOD AND SYSTEM FOR RENTING A
CONSTRUCTION MACHINE
Group Art Unit: 3629
Examiner: RUHL, Dennis William

SIR:

Attached hereto for filing are the following papers:

**REPLY TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF
APPEAL BRIEF**

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon

Registration No. 24,618

Customer Number

22850(703) 413-3000 (phone)
(703) 413-2220 (fax)

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Robert T. Pous
Registration No. 29,099



DOCKET NO. 209396US2X

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
TAKEHIRO NISHIYAMA : EXAMINER: RUHL, D.
SERIAL NO: 09/874,057 :
FILED: JUNE 6, 2001 : GROUP ART UNIT: 3629
FOR: METHOD AND SYSTEM FOR :
RENTING A CONSTRUCTION MACHINE :

REPLY TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In reply to the Notification of Non-Compliant Appeal Brief, mailed April 3, 2007, a revised Appeal Brief is herewith attached. Reconsideration is respectfully requested:

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Robert T. Pous
Attorney of Record
Registration No. 29,099

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 03/06)

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Michael Britton
Registration No. 47,260



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APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

I. REAL PARTY IN INTEREST

The real party in interest for this appeal in the present application is Kobelco Construction Machinery Co., Ltd. by way of Assignment recorded in the U.S. Patent & Trademark Office at Reel 012426, Frame 0269.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge there are no other appeals or interferences which will directly effect or be directly effected by, or have a bearing on, the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 17-21 are pending in this application. Claims 17-21 were rejected in the September 26, 2006 Office Action. Claim 1-16 and 22 have been canceled.

IV. STATUS OF AMENDMENTS

All amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention relates to a system for renting a construction machine that allows a provider of construction machine rental services to provide construction machines to a construction machine renter through a network. This system is included in independent Claim 17.

The system includes a first network terminal that allows the provider to input and update basic information related to a specification, a rental situation and a location of a construction machine through a network. See Fig. 1 and specification at page 6, line 2 through page 8, line 14.

The system includes a second network terminal that allows a renter to input another piece of basic information related to a specification of a construction machine, a requested rental period and a rental place. A preferred option of the specification, rental period and place may be input. See Fig. 2 and specification at page 10, line 10, through page 11, line 8.

The network server is connected to the terminals through the network. See Fig. 1.

The network server includes means for holding the piece of basic information input from the first terminal. See specification at page 3, lines 19-23, page 6, lines 2-6, page 7, line 24 through page 8, line 8 and page 10, lines 4-9.

The network server includes means for searching using information input through the second network terminal for information related to a construction machine for rent on the basis of the basic information input through the first terminal. See Figs. 2 and 3 and specification at page 3, line 19 through page 4, line 14, page 6, lines 2-6, page 11, lines 2-8, page 12, lines 10-15 and page 19, lines 8-14.

The network server also includes means for providing the second network terminal with the information related to the construction machine for rent as a calendar, the information including whether the construction machine is rented, vacant, under course of negotiations, and under course of or out of operation. See Figs. 5-7 and the specification at page 6, lines 2-6, page 11, lines 9-12 and page 16, lines 14-22.

With these arrangements, owners of construction machines can reduce the number of construction machines owned at any one time, maximize the use of owned machines and cope with a renter's requirements.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(1) The first rejection to be reviewed on appeal is of Claims 17-21 under 35 U.S.C. § 112, second paragraph.

(2) The second rejection to be reviewed on appeal is of Claims 17-21 under 35 U.S.C. § 102(b) over USP 5,754,850 to Janssen.

(3) The third rejection to be reviewed on appeal is of Claims 17-21 under 35 U.S.C. § 103(a) over Janssen in view of *United Rentals Inc. Launches Business to Business Equipment E-Rental Store*, PR Newswire Association Inc., February 3, 2000.

VII. ARGUMENT

A. First Rejection

The Office Action rejects Claims 17-21 under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the Office Action asserts that the recitation in Claim 17, line 28 of “under course of or out of operation” is indefinite. As discussed in the specification at page 11, lines 19-20 “in course of out of operation” refers to in course of maintenance. Thus,

the specification clearly provides support and defines the phrase “in course of out of operation.”

Claim 17 is also rejected under 35 U.S.C. § 112, second paragraph based on the assertion that the claim language “as the searched result displaying information related to ...” is indefinite and appears to be claiming a method of use. Applicant notes that the claims recite “means for providing the second network terminal with the information related to the construction machine for rent as a calendar displaying information related to the rental situation of the construction machine for rent.” Thus, this portion of the claim is using “means plus function” language under 35 U.S.C. § 112, sixth paragraph, which provides that an element in a claim for a combination may be expressed as a means for performing a specific function without the recital of structure, material or acts in support thereof and such claim may be construed to cover the corresponding structure and equivalents thereof. The recitation “displaying information” etc. relates to the specific function and is in proper means plus function format.

B. Second Rejection

Turning to the rejection of Claims 17-21 under 35 U.S.C. § 102(b) over Janssen, Janssen does not disclose means for providing the second network terminal with the information related to the construction machine for rent as a calendar displaying information related to the rental situation of the construction machine for rent, the rental situation including whether the construction machine is rented, vacant, under course of negotiations and under course of or out of operation at least during a period corresponding to the rental period inputted through the second network terminal as recited in Claim 17. Instead, Janssen is directed to a search system based on software running on a personal computer with examples directed to real estate as well as schools, doctors, cars, apartments, vacation

packages, lawyers and CPAs. Janssen contains no disclosure directed to construction machines and in particular no information provided related to the construction machine for rent as a calendar displaying information related to the rental situation of the construction machine for rent, the rental situation including whether the construction machine is rented, vacant, under course of negotiations and under course of or out of operation.

The Office Action asserts that the feature of Claim 17 “means for providing a second network terminal with the information related to the construction machine for rent” is present in Janssen inherently for example in a modem and modem driver software that would allow the data related to the search to be transmitted. Further, the Office Action asserts that the kind of data being claimed and how it is presented is not positively recited in the claim and is directed to the intended use of the system. However, as discussed above the above recitation in Claim 17 is written in “means plus function” format pursuant to 35 U.S.C. § 112, sixth paragraph. As stated in *WMS Gaming Inc. v. International Game Technology*, 184 F3d 1339, 1347, 51 USPQ2d 1385, 1390, (Fed. Cir. 1999) for a means plus function limitation to read literally on an accused device, the accused device must employ means identical to or the equivalent of the structures, material or acts described in the patent specification. The accused device must also perform the identical function as specified in the claims.

In *WMS Gaming Inc.*, the claims at issue recited a game apparatus having “means for assigning a plurality of numbers representing said angular positions of said reel, said plurality of numbers exceeding said predetermined number of radial positions such that some rotational positions are represented by a plurality of numbers.” The Federal Circuit overturned the District Court’s determination that this claim function was merely “an algorithm executed by a computer.” The Federal Circuit stated that instructions of the software program to carry out the algorithm electrically change the general purpose computer by creating electrical paths within the device. These electrical paths create a special purpose

machine for carrying out the particular algorithm. In a “means plus function” claim in which the disclosed structure is a computer or microprocessor programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm. See *WMS* at 1348, 1391.

Thus, the structure disclosed for the “means for assigning” limitation is a microprocessor programmed to assign a plurality of single numbers to stop positions such that: (1) the number of single numbers exceeds the number of stop positions; (2) each single number is assigned to only one stop position; (3) each stop position is assigned at least one single number; and (4) at least one stop position is assigned more than one single number. *Id.* at 1349, 1391.

With respect to the instant application, the function of Claim 17, in particular, providing the second network terminal with the information related to the construction machine for rent as the calendar displaying information related to rental situation of the construction machine for rent, the rental situation including whether the construction machine is rented, vacant, under course of negotiations and under course or out of operation at least during a period corresponding to the rental period inputted through the second network terminal must be performed in order for the claims to read on any asserted art. Janssen provides none of these features. Instead, the Office Action merely asserts that the use of calendars to display data relating to rental items is old and well-known. No evidence to that effect is offered. To the extent that the Examiner is using Official Notice, this assertion is respectfully traversed. Ultimately, Janssen does not disclose any features related to construction machines.

C. Third Rejection

With respect to the rejection of Claims 17-21 under 35 U.S.C. § 103(a), neither Janssen nor *United Rentals Inc.* disclose means for providing the second network terminal with the information related to the construction machine for rent as a calendar displaying information related to the rental situation of the construction machine for rent, the rental situation including whether the construction machine is rented, vacant, under course of negotiations or out of operation at least during a period corresponding to the rental period inputted through the second network terminal as in amended independent Claim 17.

As discussed above Janssen does not disclose the structure of independent Claim 17. Applicants respectfully disagree with the Office Action's assertion that *United Rentals* provides the deficiencies of Janssen. *United Rentals* does not disclose information related to the construction machine for rent including whether the construction machine is "under course of negotiations and under course of or out of operation." As disclosed in the specification at page 11, lines 9-21 in the calendar display shown in Figure 5 operating situations of various types of machines are displayed. The operating situations are displayed separately in the form of any one of the course of rental, in course of vacant, in the course of negotiations, and in course of operation (in course of maintenance). *United Rentals Inc.* discloses customers may rent and buy equipment on line review specifications of equipment available for rent, as well as browse through listings of used equipment including equipment specifications photos and operating histories. Additional users can access summaries of equipment they have out on rent, the rental rates and the status of their account. There is no information related to under course of negotiations and under course of or out of operation as well as to providing this information on a calendar. The Office Action states that the claimed data would naturally flow from the fact that the intended use of the system is for the rental of the constructions machines. However, this is impermissible hindsight reasoning using the

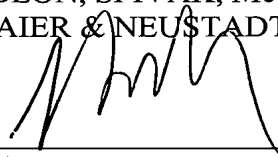
Applicant's disclosure. To establish a *prima facie* case of obviousness the prior art references must teach or suggest all the claim limitations. Thus, even if Janssen and *United Rentals* would be combined the features of Claim 17 are not disclosed. See M.P.E.P. § 2143.

VIII. CONCLUSION

In view of the above remarks, Appellant respectfully requests the rejections of the Office Action dated September 28, 2006 be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Robert T. Pous
Attorney of Record
Registration No. 29,099

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 03/06)

Michael Britton
Registration No. 47,260

APPENDIX

17. A system for renting a construction machine from a provider of a rental service of the construction machine to a person seeking the rental service of the construction machine through a network, comprising:

a first network terminal configured to enable the provider to input and update, when the provider gets access to the network, a piece of basic information related to a specification, a rental situation and a location of the construction machine for rent;

a second network terminal configured to enable the person seeking the rental service when the person gets access to the network, to input another piece of basic information related to a specification of a construction machine of his choice, rental period information including a rental period of his choice, and a rental place of his choice in such a manner that the input includes an option to identify a preferred option of one of the specification, the rental period and the rental place;

a network server adapted to be connected, respectively, to the first and the second network terminals through the network,

the network server including

means for holding the piece of basic information related to the specification, the rental situation and the location of the construction machine for rent which are input from the first network terminal through the network;

means for searching with information including the specification, the rental period and the rental place input by the second network terminal as search items, for information related to a rentable construction machine on the basis of the piece of basic information related to the specification, the rental situation and the location as input from the first network terminal and held by the network server; and

means for providing the second network terminal with the information related to the construction machine for rent as a calendar displaying information related to the rental situation of the construction machine for rent, the rental situation including whether the construction machine is rented, vacant, under course of negotiations and under course of or out of operation at least during a period corresponding to the rental period inputted through the second network terminal, wherein the means for searching carries out an equivocal search, after having searched in favor of the preferred option out of the specification, the rental period and the rental place.

18. The system according to claim 17, wherein said information related to location comprises a hierarchical structure comprising an upper location information showing a wider area as an upper class and a lower location information showing a narrower area as a lower class, and the network server searches for information related to the construction machine for rent with the upper location information as an essential search item and the lower location information as an equivocal search item.

19. The system according to claim 17, wherein said construction machine for rent is a tracklaying construction machine.

20. The system according to claim 17, wherein said information related to the specification comprises a hierarchical structure comprising an upper specification that defines a condition of not easy to change as an upper class and a lower specification that defines easy to change as a lower class, and said network server searches for information related to the construction machine for rent with information related to the upper specification as an

essential search item, and with information related to the lower specification as an in
equivocal search item

21. The system according to claim 17, wherein said network server provides the
second network terminal with information related to the construction machine for rent as a
list including information related to the location of the construction machine for rent.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.